

**REMARKS**

Claims 41-61 of the present application (“Application”) stand rejected under 35 U.S.C. 103 as obvious over Herman in view of Rogers. Claims 1-54 have been canceled. In accordance with the Examiner’s request, the Applicant has amended the drawings. No new matter has been added. In view of Remarks, the Applicant respectfully requests allowance of the pending claims.

**Rejections under 35 U.S.C. §103(a)**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); M.P.E.P. § 2143.

The Supreme Court recently reaffirmed use of the *Graham* factors for determining obviousness under 35 U.S.C. § 103(a). *KSR Int’l Co. v. Teleflex, Inc.* (*KSR*), No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims in issue; (3) the level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); 35 U.S.C. § 103.

In *KSR*, the Supreme Court recognized that the requirement for a teaching, suggestion, or motivation to modify or combine the references and arrive at the claimed invention provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a). *KSR* at 14, 15. In addition, the Court maintained that any analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it is “important to identify reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed, because “inventions in most, if not all, instances rely upon

building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.*

**Independent Claim 55**

As an initial matter, the Applicant respectfully asserts that claim 55 is allowable because the Office Action does not reject every step of claim 55.

For example, claim 55 recites the steps of:

using the information generated from the first plurality of sales transactions to determine an accessory of the first product;

generating by the electronic receipt generator a first electronic receipt for the first sales transaction, wherein the first electronic receipt comprises detailed information describing the first sales transaction, a hyperlink associated with a product return procedure for the first product, and a hyperlink associated with the determined accessory of the first product;

activating, by the buyer using the computing device, the hyperlink associated with the determined accessory of the first product;

displaying on the computing device information about the determined accessory of the first product;

The Office Action does not address or reject the steps above. Accordingly, claim 55 is allowable as a matter of law.

On page 3 of the Office Action, it is asserted that Herman discloses:

generating by the electronic receipt generator an electronic receipt including detailed information describing the sales transaction, wherein the detailed information includes sale price, total transaction amount, item description (fig. 22), information indicating completion of the transaction (col. 1, lines 63-66), and a hyperlink associated with a product return procedure (col. 2, lines 11-14); (Emphasis added)

The Applicant strongly disagrees. Herman at Col. 2, lines 9-17 discloses:

The Smart Receipt provides the customer with detailed information about an online purchase in a standardized format. Hyperlinks

embedded in the Smart Receipt enable the customer to access customer service and order status. The merchant may also embed additional services within the Smart Receipt, including special offers for future purchases. Offers provided in a Smart Receipt can be personalized to a user's preferences which are stored on the Trusted Agent Server. (Emphasis added).

Herman at Figure 22 discloses:

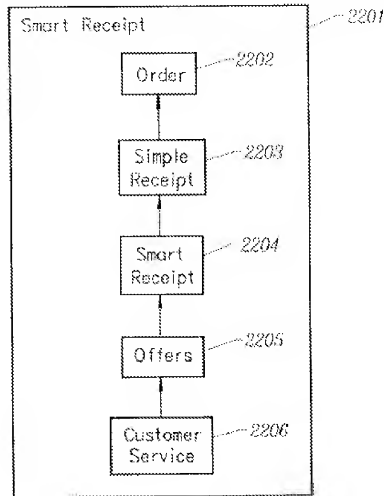


FIG. 22

As seen above, Herman does refer to “customer service.” However, Herman’s generic references to “customer service” fail to anticipate step (g) of claim 55. Specifically, the cited language fails to disclose an electronic receipt including a hyperlink associated with a return product procedure as recited in step (g). Claim 55 should be allowed for at least this reason.

On page 4 of the Office Action, it is asserted that Herman discloses:

- i.) requesting, by the buyer, a return shipping label for the product (col. 44, lines 53-55; col. 38, lines 8-24),

j.) transmitting the return shipping label to the computing device  
(col. 38, lines 8-24)

The Applicant strongly disagrees. The cited language discloses:

The Smart Receipt can contain a warranty registration card that is automatically filled out when the Buyer indicates that he has received the product. Herman at Col. 44, lines 53-55.

The direct response server enables the creation, delivery, and single-click redemption of direct response offers from anywhere on the Internet. These offers can be delivered to trusted agents according to consumer preferences, or found in a banner-like format on Web sites. The direct response server can deliver online any one of at least three classic forms of traditional direct response. First, they can handle a direct order by concluding a transaction for the product they represent without requiring a jump to any other site.

Second, they can generate a lead by transmitting a request to a merchant for additional information.

Third, they can generate store traffic, either through a link to redemption at an online commerce site, or by being printed on paper and taken for redemption to an actual retailer location. Herman at Col. 38, lines 8-24.

The above-cited language plainly fails to teach or disclose requesting, by the buyer, a return shipping label for the product by activating the hyperlink associated with a product return procedure, as recited in claim 55. There simply no reference to a return shipping label, nor to requesting, by the buyer, a return shipping label for the product by activating the hyperlink associated with a product return procedure, as recited in claim 55. The comments on pages 4-5 of the Office Action also fail to show where Herman discloses either a return shipping label, or requesting, by the buyer, a return shipping label for the product by activating the hyperlink associated with a product return procedure, as recited in claim 55.

Page 5 of the Office Action further cites to Herman at Col. 39, lines 8-59, which discloses:

Businesses of type 1 are legacy businesses that are not yet enabled with the more modern direct techniques. Therefore, type 1 businesses use the indirect technique exclusively.

Businesses of type 2 only use the direct techniques.

Businesses of type 3 can use both the direct and indirect techniques.

#### The Indirect Technique

The indirect technique communicates command operations from the trusted agent server first to the user's browser and then to a business. FIG. 12 is a block schematic diagram that depicts the indirect technique. The process flow applied by the indirect technique is as follows:

The customer (client) invokes the trusted agent service.

Interaction between the client and the trusted agent server.

The client submits Web page to business.

#### The Direct Technique

The direct technique communicates operations directly from the trusted agent server to the business. FIG. 13 is a block schematic diagram that depicts the direct technique. In the preferred embodiment of the invention, the trusted agent server communicates to the business server either using HTML or using the technology of Transactor Networks Inc. of San Francisco, California referred to as the Limited Edition Digital Object (LEDO) system. Those skilled in the art will appreciate that other protocols are possible.

#### Business Instruments and their Embodiments

The customer understands that what they are manipulating is a familiar business instrument such as a credit card, a receipt, a coupon, a warranty, a contractual offer, a medical insurance card, or other well known commercial construct. It is simple to use a credit card number to charge goods and services to a credit card account without using the actual plastic card provided by the bank.

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The following definitions are applied to the different embodiments of these business instruments:

Business Document: the entity as it is embodied on paper or plastic.

Business Affair: the entity embodied in legal and business terms.

Business Object: the entity embodied in a computer.

Business Instrument: the entity overall.

Each business instrument can be represented in several ways. In the preferred embodiment of the invention, a business object is stored as a LEDO. Those skilled in the art will appreciate that other implementations are possible, e.g. the business affair may be stored as a record in a database. A LEDO is a network digital object that has ownership that can be verified over a network. LEDOs provide efficient techniques to implement many of the legal and business issues of the instrument's business affairs. However, other, less efficient techniques may be applied to manage the instrument's business affairs.

Again, the above-cited language plainly fails to disclose either a return shipping label, or requesting, by the buyer, a return shipping label for the product by activating the hyperlink associated with a product return procedure, as recited in claim 55. Accordingly, claim 55 should be allowed for at least this reason.

By extension, Herman also fails to disclose transmitting the return shipping label to the computing device, as recited in claim 55. Accordingly, claim 55 should be allowed for at least this reason.

The Office Action on page 5 states:

However, Herman does not explicitly teach producing a hard copy of the return shipping label using the computing device. On the other hand, Rogers discloses producing a hard copy of the return shipping label using the computing device when he discloses customer sales receipt is printed with the serial numbers (col. 7, line 62 to col. 8, line 9). Rogers discloses the customer sales receipt is printed with the serial number and the transaction databases are updated. The process ends if the customer is satisfied

with the product. If not, however, the customer returns the product to the store. He discloses a link to the manufacturer's serial number database may be made to search for serial numbers which do not appear in the retailer database. Thus, it would have been obvious to one of ordinary skill in the art to produce a hard copy of the return shipping label using the computing device within the process of printing a receipt in order to handle the customer returns. (Emphasis added)

The Applicant strongly disagrees. The cited language discloses:

FIG. 5 illustrates in flow chart form an example purchase and return process made possible by the electronic registration system of the present invention. A store customer first picks out a store product for purchase (block 300) and brings it to the check out station (block 302). The store associate then scans the UPC code to enter the product SKU number (block 304) and, if it is a product for which electronic registration is sought, the store clerk is prompted to enter the serial number (block 306).

After the store clerk scans the serial number (block 308), the customer sales receipt is printed with the serial number (block 310) and the transaction databases are updated (block 312). The process ends if the customer is satisfied with the product (block 314). If not, however, the customer returns the product to the store (block 316).

The above-cited language merely discloses a paper receipt with a serial number. Claim 55 is distinguishable for several reasons. First, a sales receipt as shown in Fig. 3 of Rogers is clearly not a return shipping label. Second, Rogers by extension fails to disclose producing a return shipping label using the computing device of the user, as recited in claim 55. Third, the cited language from Herman and Rogers fails to disclose requesting and transmitting the return shipping label to be produced using the computing device, as recited in claim 55. Claim 55 is allowable for at least these reasons.

In view of the reasoning above, the Applicant respectfully asserts that claim 55 is allowable for at least the reasons that: 1) the Office Action fails to reject every step of claim 55; 2) the cited language fails to disclose step (g) of claim 55; 3) the cited language fails to disclose step (k) of claim 55; 4) the cited language fails to disclose step (l) of claim 55; 5) the cited

language fails to disclose step (m) of claim 55; 6) there can be no reason to combine the cited references and arrive at claim 55 when the references fail to disclose every step of claim 55; and 7) there can be no expectation of success at such a combination.

If the Examiner intends to maintain the rejection of claim 55, the Applicant requests clarification as to how the cited language discloses each step of claim 55.

**Dependent Claim 56**

Claim 56 includes the steps of:

generating by the electronic receipt generator information from a first plurality of electronic receipts that are associated with the buyer and that are associated with a plurality of sellers;

converting by the electronic receipt generator the information generated from the first plurality of electronic receipts to a determined format; and

transmitting the converted information generated from the first plurality of electronic receipts to the buyer.

To support a rejection of claim 56, the Office Action states:

Re claims 47-54, 56-58, and 60, Herman teaches a. generating by the electronic receipt generator information from a plurality of electronic receipts that are associated with the buyer and that are associated with a plurality of sellers; b. converting by the electronic receipt generator the information generated from the plurality of electronic receipts to a determined format; and c. transmitting the converted information generated from the plurality of electronic receipts to the buyer over a second network. (col. 20, lines 21-39; col. 38, lines 1-40; figs. 9-12)

The Applicant strongly disagrees. Herman at Col. 20, lines 21-39 discloses.

A Revenue Model is a software element that calculates how ownership transfers generate revenue for sellers or makers. A Revenue Model is designated by an ID in the Transactor object itself, designated when the object was created by its maker. The Revenue Model software component is passed information about the object, the sale price, etc. and is responsible for calculating how much of the sale price goes to seller, maker, broker, etc. These



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values are then returned to the main Financial Module for actual disbursement. Thus, the Revenue Model software component has no knowledge or interaction with accounts, bankware, etc. It only calculates shares in a revenue stream.

The above variations in underlying design should not be interpreted as uncertainty in the Transactor design or bankware interfaces. Rather, they should be treated as available options or modules determined either by the vendor who installs a Transactor system, or as required to support different payment options that may operate under different constraints (e.g., credit-cards, debit-accounts, DigiCash). (Emphasis added)

Herman at Col. 37, line 65 to Col. 38, line 40 discloses:

The trusted agent server communicates with other commerce servers. Some of these servers are designed to work closely with the trusted agent server. In the preferred embodiment of the invention, two such commerce servers are the direct response server and relationship marketing servers. Merchants and banks use these servers to communicate to customers who have accounts on a trusted agent service. These products enable such merchants and banks to conduct ongoing business relationships with customers by sending and making use of information stored online in the consumers trusted agent.

The direct response server enables the creation, delivery, and single-click redemption of direct response offers from anywhere on the Internet. These offers can be delivered to trusted agents according to consumer preferences, or found in a banner-like format on Web sites. The direct response server can deliver online any one of at least three classic forms of traditional direct response.

First, they can handle a direct order by concluding a transaction for the product they represent without requiring a jump to any other site.

Second, they can generate a lead by transmitting a request to a merchant for additional information.

Third, they can generate store traffic, either through a link to redemption at an online commerce site, or by being printed on paper and taken for redemption to an actual retailer location.

The relationship marketing server uses smart receipts as the basis for after-market consumer care. When a consumer buys a product, the merchants relationship marketing server generates a unique digital object in the form of a smart receipt which contains all of the information needed for consumer care. The relationship marketing server sends this information to the customer's trusted agent. The customer can open his trusted agent using a URL, click on the smart receipt, and be presented with a number of services, such as automatically routed requests for customer service or return authorizations, 800 number listings to call for help, order status tracking (for example, offered in eventual partnership with such shipping companies as Federal Express or UPS), and pre-formatted and routed requests for related product offers. (Emphasis added)

The four figures cited by the Office Action disclose:

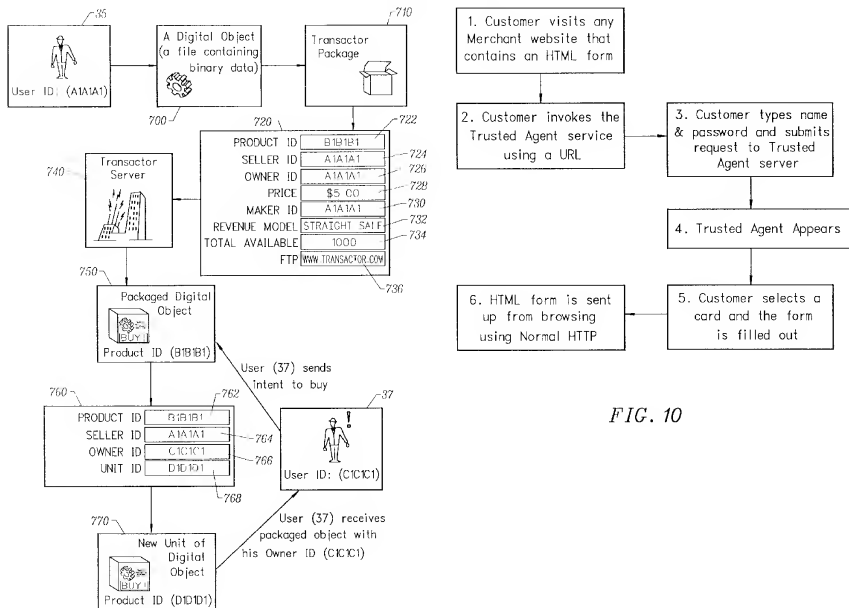


FIG. 9

FIG. 10

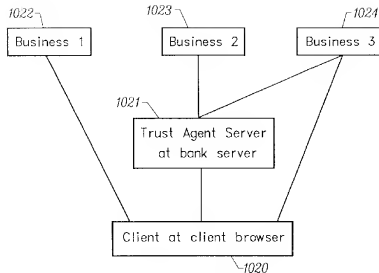


FIG. 11

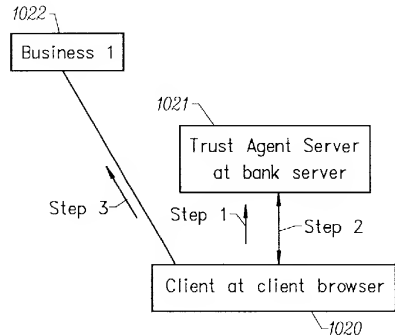


FIG. 12

The Applicant respectfully asserts that claim 56 is allowable for several reasons. First, the cited language does not disclose generating information from a plurality of electronic receipts that are associated with the buyer and that are associated with a plurality of sellers, as recited in claim 56. The “Revenue Model” software calculates how ownership transfers generate revenue for sellers or makers, which clearly does not teach or disclose generating information from a plurality of electronic receipts that are associated with the buyer and that are associated with a plurality of sellers, as recited in claim 56.

Second, the cited language clearly makes no reference to converting by an electronic receipt generator the information generated from the first plurality of electronic receipts to a determined format, as recited in claim 56. The cited language makes no reference to converting anything.

Third, by extension, the cited language fails to disclose transmitting the converted information generated from the first plurality of electronic receipts to the buyer, as recited in claim 56.

Accordingly, claim 56 is allowable for at least the reasons that: 1) the cited language fails to disclose step (a) of claim 56; 2) the cited language fails to disclose step (b) of claim 56; 3) the cited language fails to disclose step (c) of claim 56; 4) there can be no reason to combine the cited references and arrive at claim 56 when the references fail to disclose every step of claim

56; 5) there can be no expectation of success at such a combination; and 6) claim 56 depends from an allowable claim.

If the Examiner intends to maintain the rejection of claim 56, the Applicant requests clarification as to how the cited language discloses each step of claim 56.

#### **Dependent Claim 57**

Claim 57 depends from claim 56, and so claim 57 is allowable for at least the reason that it depends from an allowable claim.

Claim 57 is also allowable for several additional reasons. First, the cited language does not disclose generating information from a second plurality of electronic receipts that are associated with the first seller and a plurality of buyers, as recited in claim 57. Second, the cited language does not disclose converting anything, and so does not disclose converting the information from the second plurality of electronic receipts to a determined format, as recited in claim 57. Third, by extension, the cited language does not disclose transmitting the converted information generated from the second plurality of receipts to one or more sellers, as recited in claim 57.

If the Examiner intends to maintain the rejection of claim 57, the Applicant requests clarification as to how the cited language discloses each step of claim 57.

#### **Dependent Claim 58**

Claim 58 depends from claim 57, and so claim 58 is allowable for at least the reason that it depends from an allowable claim.

Claim 58 is also allowable for several additional reasons. First, the cited language does not disclose generating information from a third plurality of electronic receipts that are associated with a plurality of buyers and sellers, as recited in claim 58. Second, by extension, the cited language does not disclose using the information generated from the third plurality of receipts by a third party to perform market research, as recited in claim 58.

If the Examiner intends to maintain the rejection of claim 58, the Applicant requests clarification as to how the cited language discloses each step of claim 58.

**Independent Claim 59**

The Applicant respectfully asserts that claim 59 is allowable as a matter of law because the Office Action does not reject every step of claim 59. For example, claim 59 recites the steps of:

generating by the electronic receipt generator information from the first plurality of electronic receipts that describes the first plurality of sales transactions but that does not personally identify any individual buyer;

transmitting the information generated from the first plurality of electronic receipts to a third party; and

performing market analysis by the third party using the information generated from the first plurality of electronic receipts.

The Office Action does not address or reject the steps above. Accordingly, claim 59 is allowable as a matter of law.

**Dependent Claim 60**

Claim 60 is similar to claim 56, and so is allowable for at least the reasons given for the allowability of claim 56. Claim 60 is also allowable for at least the reason that it depends from allowable claim 59.

If the Examiner intends to maintain the rejection of claim 60, the Applicant requests clarification as to how the cited language discloses each step of claim 60.

**Dependent Claim 61**

Claim 61 is allowable for at least the reason that it depends from allowable claim 60. Claim 61 is similar to claim 55, and so it allowable for at least the reasons given for the allowability of claim 55. For example, claim 61 is allowable for at least the reason that the cited language does not disclose generating an electronic receipt including a hyperlink associated with a product return procedure, transmitting in response to activation of the hyperlink return

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information containing steps for returning the product, and requesting, transmitting, and producing a return shipping label, as recited in claim 61.

If the Examiner intends to maintain the rejection of claim 61, the Applicant requests clarification as to how the cited language discloses each step of claim 61.

**CONCLUSION**

In view of the above, each of the presently pending claims in the Application is believed to be in immediate condition for allowance. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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